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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,968	05/10/2001	Eugene Y. Chan	C0989/7016(HCL)	5672

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EXAMINER	
MUMMERT, STEPHANIE KANE	
ART UNIT	**PAPER NUMBER**
1637	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/852,968	CHAN, EUGENE Y.	
	Examiner	Art Unit	
	Stephanie K. Mummert	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-157 is/are pending in the application.

4a) Of the above claim(s) 3-22, 84-88 and 158-160 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1,2,23-83 and 89-157 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

SDD

DETAILED ACTION

A preliminary amendment, filed January 9, 2002, canceling claims 3-22, 84-88 and 158-160 has been entered. Claims 1-2, 23-83 and 89-157 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2, 98, 115-124 and 130-156, drawn to a method for analyzing units of a polymer, classified in class 422, subclass 68.1.

II. Claims 77-83 and 89-97, drawn to a method of preparing a wall material, classified in class 435, subclass 288.7.

III. Claims 23-76, 99-114 and 157, drawn to an apparatus and article(s) of manufacture, classified in class 435, subclass 283.1.

IV. Claims 125-129, drawn to a method for labeling nucleic acids, classified in class 435, subclass 6.

1. Inventions I and II, IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different groups are drawn to distinct and separate inventions. The method of group I is not related in materials, method steps, or end result to the method(s) of group II or IV. There is also no clear disclosure that these methods can be practiced together. For these reasons, each of these methods are distinct. Group I results in polymer analysis, group II results in the construction of an article of manufacture, as part of a larger apparatus and group IV results in labeling of nucleic

acids. A search of one of the methods would not be coextensive with either of the other two methods. Each method would require a separate search with distinct search terms in different areas of the prior art. Therefore, to search each of the inventions together would pose an undue burden on the examiner.

2. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the apparatus or article(s) of manufacture could be used to determine binding between complementary nucleotide sequences within the channel(s) or the apparatus could be used to attach a label or tag to a polymer of interest.

3. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of group II is directed to the manufacture of "an article of manufacture" comprising a wall material that can be incorporated into the apparatus as claimed in group III. The method is directed to covalently bonding a light emissive or quenching compound to a plurality of discrete locations. The apparatus or article of manufacture can also be made with non-covalent attachment of the light emissive or quenching compounds. The article of manufacture

and/or apparatus can also be made using alternative techniques such as etching, stenciling or single-piece molding. Since the method and the apparatus are distinct and separate inventions, a search of one would not be coextensive with the other and would require distinct searches. Therefore, to search the inventions together would pose an undue burden on the examiner.

4. Inventions II-III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different groups are drawn to distinct and separate inventions. The method of group II and the apparatus of group III are related as process of making and product made, but neither of these inventions are disclosed as useful in the method of group IV, instead the labeling generally occurs prior to processing the polymer(s) using the apparatus of group III of the instant application. A search of the method of labeling of group IV would not be coextensive with a search of either the method of manufacture of group II or the apparatus of group III. To search each of these distinct inventions together would pose an undue burden on the examiner.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise

include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply

where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie K. Mummert whose telephone number is 571-272-8503. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephanie K. Mummert

Stephanie K. Mummert
Patent Examiner
Art Unit 1637

JEFFREY FREDMAN
PRIMARY EXAMINER
9/23/05